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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,612	01/13/2006	Roger T Richter	023265.0002US	7639
34284	7590	07/13/2007	EXAMINER	
Rutan & Tucker, LLP. Hani Z. Sayed 611 ANTON BLVD SUITE 1400 COSTA MESA, CA 92626			KRECK, JOHN J	
			ART UNIT	PAPER NUMBER
			3673	
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			07/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,612	Applicant(s) RICHTER, ROGER T	
	Examiner John Kreck	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment dated 4/26/07 is entered.

Priority

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of

Art Unit: 3673

such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

The references cited in the Search Report for PCT/US03/38839 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 02/094464A2. It is noted that this represents applicant's previous work. The instant application has a filing date of 5 December 2003---see above for priority claim. The WO publication published on 28 November 2002.

2. Claims 1-13, 15-25, 27, 28, 34-36, 39, and 40 are rejected under 35

U.S.C. 102(b) as being anticipated by Vinegar, et al. (U.S. Patent number 5,318,116)

Vinegar discloses the system comprising a soil remediation cell (10); a plurality (see figure 1) of multifunctional conduits (fig.2), each conduit including heating elements (20); flow channels (including 16 and 17); and a reaction housing (e.g. near 19) as called for in claim 1. With regards to the limitation of "without utilizing mechanically driven forced air" and "at least about 80%" destroyed. These are interpreted as operational parameters. It is apparent that the Vinegar device can perform the claimed operations. : Vinegar plainly discloses the device is capable of producing temperatures (e.g. figure 6) which would vaporize contaminants without vacuum. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In this case, applicant does not claim any structure which defines over the Vinegar apparatus.

Re claims 2 and 3: Vinegar shows the perforations at 16, and the non-perforated portions are evident in the figure.

Re. Claims 4, 5, 8-13, 15, 18, 19, 22, 28, 36: these claims add only operational parameters as limitations. It is apparent that the Vinegar device can perform the claimed operations.

RE claim 16: Vinegar plainly shows the tubes.

RE claim 17: see Vinegar at 8:46.

RE claim 21: see Vinegar at 4:53.

RE claim 27: see Vinegar at 5:20.

RE claim 34-36: the vapor space is shown between 29 and 29a, or, alternatively, directly below 34.

3. Claims 1, 2, 13, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by McGee (U.S. Patent number 6,596,142).

McGee teaches the system comprising a soil remediation cell (e.g. fig. 11); a plurality of multifunctional conduits (each including 15,4,18), each conduit including heating elements (34); flow channels (e.g. 17); and a reaction housing as called for in claim 1. With regards to the limitation of “without utilizing mechanically driven forced air” and “at least about 80%” destroyed. These are interpreted as operational parameters. It is apparent that the McGee device can perform the claimed operations. With regards to the newly added limitation, which requires the system to not utilize vacuum to encourage reactants to achieve a contaminated vapor: it is apparent that this is also an inherent feature of the McGee apparatus

RE claim 2: the perforations are shown at 8.

RE claims 13 and 14: the perforated portion is joined with the non-perforated near 14; which plainly is at the center.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vinegar in view of Bova, et al. (U.S. Patent number 6,000,882).

Vinegar lacks the claimed layers of soil.

Bova teaches a similar system, which includes layers of soil. It is apparent that the soil layers are a largely a matter of convenience.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Vinegar system to have included a plurality of adjacent layers of soil as called for in claim 26.

5. Claims 29, 30, 33, and 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinegar in view of Balch (U.S. Patent number 5,228,804).

Vinegar lacks the structural enclosure.

Balch teaches a similar system, including a structural enclosure. It is apparent that the structural enclosure provides convenience for treating excavated soil. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Vinegar system to have included a structural enclosure as called for in claims 29-31 and 33.

With regards to claim 30: the open bottom is discussed at Balch 6:26.

With regards to claim 33: see Balch at 7:7-25.

Vinegar teaches insulation (see abstract) as called for in claim 37.

6. Claims 29, 31, 32, 37, and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinegar in view of Payne (U.S. Patent number 4,919,570)

Vinegar lacks the structural enclosure and trailer.

Payne teaches a similar system, including a structural enclosure and trailer. It is apparent that the Payne enclosure provides portability.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Vinegar system to have included a structural enclosure as taught by Payne, to provide portability.

With regards to claim 31: the structural members are 16.

With regards to claim 32: the trailer is 68.

Vinegar teaches insulation (see abstract) as called for in claim 37.

With regards to claim 38: the structures shown by Payne are stackable see 3:25-30.

Response to Arguments

1. Applicant's amendment and arguments regarding process claims 39 and 40 have overcome the rejections based on Vinegar—the process described by Vinegar plainly utilizes forced air in the form of vacuum or suction.

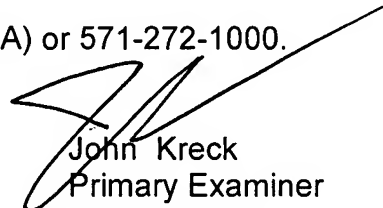
2. Applicant's further arguments concerning the apparatus claims have been fully considered but they are not persuasive. Applicant has argued that the Vinegar and McGee references do not anticipate the claimed apparatus since they disclose the use of suction or vacuum. This is not persuasive, because applicant has not shown any structural difference between the cited references and the claimed invention. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

3. Applicant's further arguments concerning the various rejections of claims 26, 29, 30, 33, 37, 31, 32, and 38 are not persuasive: because they amount to a general allegation that the claims define a patentable invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is 571-272-7042. The examiner can normally be reached on Mon-Thurs 530am-2pm; Fri: telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Kreck
Primary Examiner
Art Unit 3673

5 July 2007